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Remarks

Reconsideration of the above-captioned application is respectfully requested. All pending claims (1-31) have been rejected as being unpatentable over Oberteuffer et al. in view of Kono, and Claims 15-20 have been rejected for an antecedent basis discrepancy which has been corrected by the amendments herein and will not be further addressed.

To promote prosecution, independent apparatus Claim 1 has been amended to recite that the processor responds to a graphics input mode by outputting content in a graphics output mode using a graphic user interface, the processor also responding to an audio input mode by outputting content in an audio output mode using an audio user interface. Support for this amendment can be found in the specification on page 3, first full paragraph. In contrast, independent Claim 13 now recites that for each tangible interface the abstract interface stores information including a current position in content being rendered and/or a spanning region of the content being rendered, such that first and second output threads are run simultaneously with each other, with the abstract interface also determining positions at which tangible interfaces should pause when required to coordinate the multiple output modes as disclosed on page 9, first full paragraph. On the other hand, independent Claim 27 now recites that the content is book content and that the output threads are run responsive to plural input modes. Claims 1-31 remain pending.

Rejections Under 35 U.S.C. §103

Claims 1-31 have been rejected under 35 U.S.C. §103 as being unpatentable over Oberteuffer et al. in view of Kono. This rejection suffers from more than one violation of the MPEP which will be discussed in turn.

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First, MPEP §2111.01 does not permit claim terms to be given any broad interpretation that might be convenient to reject a claim, but rather requires that claim terms be construed as broadly as *one skilled in the art* would construe them. With this in mind, the allegation that the multi-mode input device of Oberteuffer et al. is an "electronic book", coming as it does without any evidence from the prior art that the skilled artisan would regard an input device as an electronic book, which fundamentally is an output device, cannot be sustained. The fact that Oberteuffer et al., col. 2, line 55 compares the size of a computer to the size of a book is of course an irrelevancy, since "book" in this context is not being equated to anything that Oberteuffer et al. teaches but rather is used as a mere example of volumetric size, like a breadbox might be. In fact, Oberteuffer et al. lacks the very characteristic - book content - that makes an electronic book a book at all. Likewise, various other allegations revolve around overly broad constructions of claim terms that appear to be untethered from the understanding of those skilled in the art, e.g., the construction of "interface" to encompass "processor". Should these claim interpretations be adhered to, evidence from the prior art of their legitimacy to those skilled in the e-book art is requested, see In re Dembicak, 175 F.3D 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (the range of sources available does not diminish the requirement for **actual evidence**, and "broad conclusory statements are not evidence").

With the above in mind, the second violation of the MPEP (§2143.01) is that proffered suggestion to combine lacks the requisite prior art motivation. First, there is no explanation of why someone would be motivated to combine an electronic book reference such as Kono with something that is not an electronic book as that term is understood in the art, such as the input device of Oberteuffer et al. that contains no content at all except whatever the user puts into it.

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Second, the preferred suggestion to use the multi mode output of Kono with Oberteuffer et al., namely, that to do so "enhances understanding of graphically displayed content", bears no relevance to Oberteuffer et al., which displays no book content at all. Instead, all Oberteuffer et al. does is accept voice input and handwriting input for digitizing them into computer files, something that nothing in the prior art, particularly Oberteuffer et al., suggests must be improved by providing multi-mode output. In other words, the user of Oberteuffer et al. does not seek to access content from anything, but rather to input content already known to the user into a computer file, thus requiring no multi-modal repetitive output of what the user has just input. Consequently, while Kono has a reason for its multi mode output, that reason has no relevance in the context of Oberteuffer et al., the reference sought to be modified. The converse is also true - that while Kono seeks to provide multiple output modes, there is no reason or suggestion in Kono to employ multiple input modes in lieu of its graphics-only mode, because Kono makes no recognition that would support such a modification in its particular context, see MPEP §2143.01 (the mere fact that a reference can be modified does not render an invention obvious, unless the modification is suggested by the prior art, citing *In re Mills*). Accordingly, a *prima facie* case of obviousness has not been properly made under the MPEP, because the requisite prior art suggestion to combine the two references is missing, rendering the claims patentable.

Apart from the deficiencies in the *prima facie* case, even if the references were combined as proposed the present claims would not result. Consider amended Claim 1, which requires the processor to respond to a graphics input mode by outputting content in a graphics output mode using a graphic user interface and also to respond to an audio input mode by outputting content in an audio output mode using an audio user interface. This specific correspondence between plural input modes and plural output modes cannot possibly

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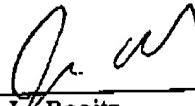
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be taught or suggested in the combined references since neither envisions both a multi mode input and a multi mode output, much less any correspondence between them. Amended independent Claim 27, which requires both plural input modes and output threads, is also patentable.

Further, nothing in the relied-upon references suggests maintaining a current position in content and/or a spanning region of the content being rendered such that first and second output threads are run simultaneously with each other, as now set forth in Claim 13, much less do the references teach determining positions at which tangible interfaces should pause when required to coordinate the multiple output modes.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,


John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

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